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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/564,644	01/13/2006	Yasuo Shirasaki	576PO84	1508

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EXAMINER

KLEMANSKI, HELENE G

ART UNIT PAPER NUMBER

1755

DATE MAILED: 10/04/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/564,644

Applicant(s)

SHIRASAKI ET AL.

Examiner

Helene Klemanski

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____                                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/28/06</u> .   | 6) <input type="checkbox"/> Other: ____                           |

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. The references cited in the Search Report dated October 12, 2004 have been considered.

### ***Specification***

2. The abstract of the disclosure is objected to because it is more than 1 paragraph in length. Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

3. Claims 1 and 3-5 are objected to because of the following informalities: in claim 1, the first line after formula (1), the left parenthesis should be deleted; also in claim 1, the first line after the formula (2), the left parenthesis should be deleted; further in claim 1, the fifth line after the formula (2), the right parenthesis should be deleted; lastly in claim 1, the ninth line after the formula (2), the right parenthesis should be deleted; in claim 3, line 1, the term "Claim1" should be replaced with the term "Claim 1" and the term "Claim2" should be replaced with the term "Claim 2"; in claim 4, line 1, the term "Claim1" should be replaced with the term "Claim 1" and the term "Claim3" should be replaced with the term "Claim 3" and in claim 5, a period should be inserted after the formula (4). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 1 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, the phrase "depending on the circumstances" is considered vague and indefinite since it is impossible to determine what the circumstances encompass. The examiner suggests the deletion of the phrase to overcome this rejection.

***Claim Rejections - 35 USC § 103***

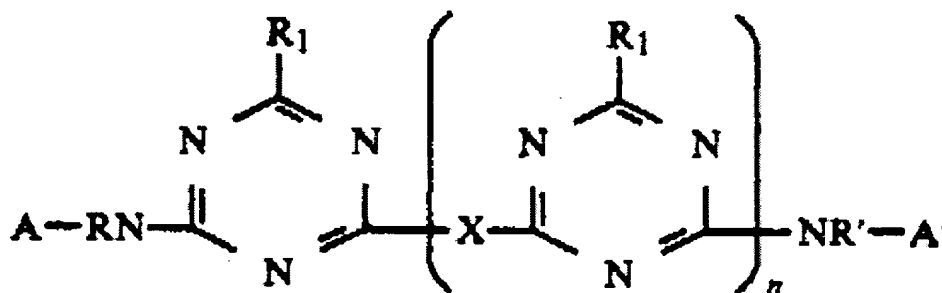
6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

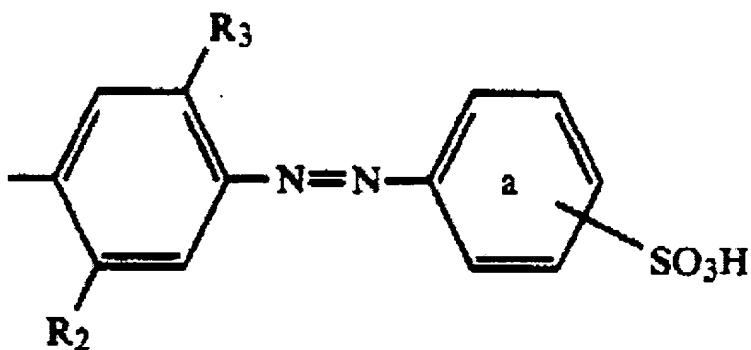
7. Claims 1-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schaulin et al. (US 5,328,995).

Schaulin et al. teach a disazo compound of the formula

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wherein A and A' are the radical of the formula



R and R' are each H; R<sub>1</sub> is sulfo- or carboxyl-substituted N-mono or N,N-di-

C<sub>1-4</sub>alkylamino, carboxyl- and/or sulfo-substituted phenylamino; X is a bridge member of the formula



wherein R<sub>5</sub> and R'<sub>5</sub> are each H; n is 0 or 1 and R<sub>2</sub> and R<sub>3</sub> are each C<sub>1-4</sub> alkoxy. The disazo compound is useful as a dye for dyeing or printing nitrogen-containing or cellulosic materials and are also suitable as colorants in aqueous ink jet printing inks.

See col. 1, line 9 – col. 2, line 50, col. 3, lines 8-24 and lines 52-53, col. 4, lines 1-3 and lines 25-34, col. 5, lines 46-49, col. 9, line 67 – col. 10, line 8 and col. 10, lines 54-56.

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Schaulin et al. fails to specifically exemplify the use of a disazo compound wherein n is equal to 1 as claimed by applicants.

Therefore, it would have been obvious to one having ordinary skill in the art to use the specific disazo dye wherein n is equal to 1 as claimed by applicants as Schaulin et al. also discloses the use of these disazo compounds but fails to show an example incorporating them.

### ***Conclusion***

The remaining references listed on forms 892 and 1449 have been reviewed by the examiner and are considered to be cumulative to or less material than the prior art references relied upon in the above rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK

September 28, 2006